

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Rozhon et al.

Application No.: 09/712,033

Group Art Unit: 1651

Filed: November 14, 2000

Examiner: To Be Assigned

For: ENTERIC FORMULATIONS OF  
PROANTHOCYANIDIN  
POLYMER ANTI-DIARRHEAL  
COMPOSITIONS

Attorney Docket No.: 7032-073

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REQUEST UNDER 37 C.F.R. § 1.36 AND §10.40(c)  
FOR WITHDRAWAL OF ATTORNEYAssistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

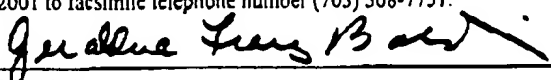
It is hereby requested that the attorneys who have appeared in the above-identified patent application, and whose names appear below, be permitted to withdraw as attorneys in accordance with 37 C.F.R. §§ 1.36 and 10.40(c). It is respectfully requested that this Request be approved for the reasons stated herein.

As required, an original and two copies of this Request are being filed herewith.

The undersigned attorney has authorization and submits this Request on behalf of the following individuals:

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being filed with the United States Patent and Trademark Office by facsimile transmission on May 3, 2001 to facsimile telephone number (703) 308-7751.

  
Geraldine F. Baldwin

31,232

(Reg. No.)

S. Leslie Misrock (Reg. No. 18872), Harry C. Jones, III (Reg. No. 20280), Berj A. Terzian (Reg. No. 20060), Gerald J. Flintoft (Reg. No. 20823), David Weild, III (Reg. No. 21094), Jonathan A. Marshall (Reg. No. 24614), Barry D. Rein (Reg. No. 22411), Stanton T. Lawrence, III (Reg. No. 25736), Isaac Jarkovsky (Reg. No. 22713), Joseph V. Colaianne (Reg. No. 20019), Charles E. McKenney (Reg. No. 22795), Philip T. Shannon (Reg. No. 24278), Francis E. Morris (Reg. No. 24615), Charles E. Miller (Reg. No. 24576), Gidon D. Stern (Reg. No. 27469), John J. Lauter, Jr. (Reg. No. 27814), Brian M. Poissant (Reg. No. 28462), Brian D. Coggio (Reg. No. 27624), Rory J. Radding (Reg. No. 28749), Stephen J. Harbulak (Reg. No. 29166), Donald J. Goodell (Reg. No. 19766), James N. Palik (Reg. No. 25510), Thomas E. Friebe (Reg. No. 29258), Laura A. Coruzzi (Reg. No. 30742), Jennifer Gordon (Reg. No. 30753), Jon R. Stark (Reg. No. 30111), Allan A. Fanucci (Reg. No. 30256), Geraldine F. Baldwin (Reg. No. 31232), Victor N. Balancia (Reg. No. 31231), Samuel B. Abrams (Reg. No. 30605), Steven I. Wallach (Reg. No. 35402), Marcia H. Sundeen (Reg. No. 30893), Paul J. Zegger (Reg. No. 33821), Edward R. Bannon (Reg. No. 32110), Bruce J. Barker (Reg. No. 33291), Adriane M. Antler (Reg. No. 32605), Thomas G. Rowan (Reg. No. 34419), Ann L. Gisolfi (Reg. No. 31956), Mark A. Farley (Reg. No. 33170) and James G. Markey (Reg. No. 31636).

The present mailing address of each of the above-named individuals is:

PENNIE & EDMONDS LLP  
1155 Avenue of the Americas  
New York, New York 10036  
Tel.: (212) 790-9090

### REMARKS

The Commissioner usually requires that there be "at least thirty days between approval of the withdrawal and the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 C.F.R. § 1.136(a)." M.P.E.P. § 402.06. In the present application, a Notice to File Missing Parts of Application ("Notice") was mailed on April 18, 2001. The time period set for response to the Notice is two (2) months from the mailing date of the Notice. Accordingly, a response to the April 18, 2001 Notice is due on June 18, 2001. However, the Notice provides

that extensions of time for response may be obtained under the provisions of 37 C.F.R.

§ 1.136(a). Thus, in accordance with 37 C.F.R. § 1.136(a), the time period for reply to the Notice may be extended until October 18, 2001 by the filing of a petition and the appropriate fee. Accordingly, in order for the attorneys who have appeared in the above-identified application to withdraw as attorneys in connection with the above-identified application, the present petition must be approved on or before September 18, 2001, *i.e.*, 30 days before the non-extendible deadline of October 18, 2001. In view of the foregoing, the attorneys requesting withdrawal respectfully request approval of the present petition to withdraw on or before September 18, 2001.

The facts that support this request for withdrawal are set forth below.

The instant application names Edward Rozhon, Akran Sabouni, Atul S. Khandwala, Gul P. Balwani, Jody Wai-Han Chan and David Scsin as co-inventors.

Our client, a corporate entity known as Shaman Pharmaceuticals, Inc. (hereinafter referred to as "Client"), retained the undersigned, *inter alia*, to prepare and prosecute the instant application, as well as the parent and grandparent applications of the instant application. Ultimately, the instant application was filed on November 14, 2000 as a continuation application of application Serial No. 09/066,989, filed April 23, 1998, now abandoned ("the '989 application"), with a copy of the executed Declaration and Power of Attorney from the '989 application which named the attorneys herein, *i.e.*, those individuals now requesting withdrawal. The '989 application, and thereby, the instant application was assigned to Shaman Pharmaceuticals, Inc. by assignment of all inventors recorded at Reel 10194, Frame 0568 on August 25, 1998 and Reel 10489, Frame 0941 on January 11, 2000.

Pursuant to 37 C.F.R. § 1.36, an attorney or agent may withdraw upon application to and approval by the Commissioner. Further, 37 C.F.R. § 10.40(a) states that a

practitioner shall not withdraw without permission from the United States Patent and Trademark Office until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to the client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. Under 37 C.F.R. § 10.40(c), permissive withdrawal is permitted, *inter alia*, when the client has failed to pay one or more bills for an unreasonable period of time.

The undersigned and the attorneys named herein are seeking permissive withdrawal under 37 C.F.R. § 10.40(c), for failure to pay one or more bills, rendered by the undersigned, for an unreasonable period of time. Client has been and is presently in arrears for invoices dating back to November 12, 1998. Although client has made some payments since the November 12, 1998 invoice, Client has accumulated an unpaid balance of over \$70,000. On or about September 25, 2000, Client's account was turned over to a collection agency in attempt to secure payment of the then outstanding balance of \$29,945.55. On January 5, 2001, Client initiated Chapter 11 proceedings, and Pennie & Edmonds LLP, the undersigned's law firm, has a claim for \$65,156.30 as an unsecured creditor.

Throughout the prosecution of the present application, Client has been provided with copies of all papers filed on their behalf by the undersigned attorneys, and all papers issued by the Patent and Trademark Office in connection with the above-identified application. In addition, the original prosecution file for the instant application is being shipped to Dr. Steven King, an employee of Client, at the Client by overnight courier on even date herewith. Dr. King has been notified of this shipment by telephone.

Client has been advised of the undersigned's intent to withdraw in a telephone conversation between the undersigned and Dr. Steven King on April 25, 2001.

**THE REQUEST UNDER 37 C.F.R. §§ 1.36 and 10.40 SHOULD BE APPROVED**

As shown above, Client has failed for an unreasonable period of time to pay for professional services rendered in connection with the instant application. The payment policy of the attorneys requesting withdrawal is that all statements are due when rendered. No credit is given. Therefore, it is unreasonable to fail to pay for more than two years bills that are due when payable. Thus, attorneys request permission to withdraw under 37 C.F.R. § 10.40(c)(1)(vi).

As shown above, reasonable steps have been taken to avoid foreseeable prejudice to the rights of the Client, owner of the application. Thus, the undersigned respectfully requests to be permitted to withdraw as attorney in the prosecution of this application. The undersigned attorney also submits this request on behalf of: S. Leslie Misrock (Reg. No. 18872), Harry C. Jones, III (Reg. No. 20280), Berj A. Terzian (Reg. No. 20060), Gerald J. Flintoft (Reg. No. 20823), David Weild, III (Reg. No. 21094), Jonathan A. Marshall (Reg. No. 24614), Barry D. Rein (Reg. No. 22411), Stanton T. Lawrence, III (Reg. No. 25736), Isaac Jarkovsky (Reg. No. 22713), Joseph V. Colaianni (Reg. No. 20019), Charles E. McKenney (Reg. No. 22795), Philip T. Shannon (Reg. No. 24278), Francis E. Morris (Reg. No. 24615), Charles E. Miller (Reg. No. 24576), Gidon D. Stern (Reg. No. 27469), John J. Lauter, Jr. (Reg. No. 27814), Brian M. Poissant (Reg. No. 28462), Brian D. Coggio (Reg. No. 27624), Rory J. Radding (Reg. No. 28749), Stephen J. Harbulak (Reg. No. 29166), Donald J. Goodell (Reg. No. 19766), James N. Palik (Reg. No. 25510), Thomas E. Friebe (Reg. No. 29258), Laura A. Coruzzi (Reg. No. 30742), Jennifer Gordon (Reg. No. 30753), Jon R. Stark (Reg. No. 30111), Allan A. Fanucci (Reg. No. 30,256), Geraldine F. Baldwin (Reg. No. 31232), Victor N. Balancia (Reg. No. 31231), Samuel B. Abrams (Reg. No. 30605), Steven I. Wallach (Reg. No. 35402), Marcia H. Sundeen (Reg. No. 30893), Paul

J. Zegger (Reg. No. 33821), Edward R. Bannon (Reg. No. 32110), Bruce I. Barker (Reg. No. 33291), Adriane M. Antler (Reg. No. 32605), Thomas G. Rowan (Reg. No. 34419), Ann L. Gisolfi (Reg. No. 31956), Mark A. Farley (Reg. No. 33170) and James G. Markey (Reg. No. 31636). The present mailing address of each of the above named-individuals is:

PENNIE & EDMONDS LLP  
1155 Avenue of the Americas  
New York, New York 10036

The undersigned attorney is providing copies of this Request to Client.

### CONCLUSION


For the foregoing reasons, this Request to Withdraw meets the criteria of 37 C.F.R. §§ 1.36 and 10.40(c) and should be approved. In sum, Client has failed to pay one or more bills for an unreasonable period of time; and in accordance with 37 C.F.R. § 10.40(a), Client has been given due notice of the withdrawal; has received copies of all papers and property to which it is entitled; and has been given sufficient time to employ another practitioner.

It is respectfully requested that this Request to Withdraw be granted at the earliest convenience of the United States Patent and Trademark Office, and in any event, no later than September 18, 2001.

No fee is believed to be due in connection with filing of the instant request. However, if a fee is due, please charge the required fee to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,

Date May 3, 2001

  
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Enclosure (two copies of this request)